

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 28, 2006. Reconsideration and favorable action are respectfully requested in view of the following remarks.

Section 103 Rejections

Claims 1-2, 6-7, 11-15, 19-20, 24-26, 28-31, 37, 40-41, 43-46, 52 and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,148,290 issued to Dan, et al. ("*Dan*") in view of U.S. Patent No. 6,684,329 issued to Epsteine et al. ("*Epsteine*"). Applicants respectfully traverse these rejections.

Independent Claim 1 is allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently "determining whether the data violates the agreement." The Office Action points to Column 6, lines 25-47 of *Dan* as an alleged disclosure of this feature, but this is incorrect. This portion of *Dan* describes an automatic generation of code used to implement a service contract – not determining whether data violates the agreement. Other portions of *Dan* discuss enforcement code that:

. . . can log the request (noting time and content), number the request for correlation to an anticipated response, provide a signing function, include a timer function and notification in event of timeout and pass the request by a chosen protocol. When receiving a request or response from the service application 500, the enforcement code component can provide some of the functions listed hereinabove and also can determine whether the message is a response or a request, check validity of response and take appropriate action.

(*Dan*, Column 6, lines 51-56). However, this certainly is not determining whether the data violates the agreement. Furthermore, Applicants are unaware of a disclosure in *Epsteine*, which could reasonably be interpreted as a disclosure of determining whether the data violates the agreement. For at least this reason, Applicants submit that Independent Claim 1 and its dependents should be allowed.

Independent Claim 1 is further allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently "disallowing communication of the data from the first virtual private proxy to the second virtual private proxy when the data violates

the agreement.” The Office Action acknowledged that *Dan* does not disclose this feature. *See* Office Action, page 3. Rather, the Office Action pointed to *Epsteine* at Column 8, Line 56 - Column 9, line 23, but this is incorrect. The entirety of this portion is below:

FIGS. 6A and 6B illustrate the sequences for a successful or unsuccessful protocol operation. Consider first the successful sequence of operations in FIG. 6A. The operation starts on the inside network 210, where a client application sends a request (S1) to the inside listener/sender (proxy A) 512. Access controls may be performed at this step before the request is externalized into a file and transferred (S2) to content-based filter 516. Content-based filter 516 makes a decision based on the contents of the request, and forwards the file (S3) to the outside listener/sender (proxy B) 514. The file is then converted from the file format back into the original protocol format, and sent to the server on the outside network 220. When the server responds (S5), the outside listener/sender 514 may perform access controls, and then convert the response to a file. The file continues back through the content-based filter 516 (S6) to the inside listener/sender 512 (S7), where it is converted back into a protocol stream and sent to the originating client.

(*Epsteine*, Column 8, Line 56 - Column 9, line 23). Clearly, the above passage provides no disclosure of disallowing communication of the data from the first virtual private proxy to the second virtual private proxy when the data violates the agreement. For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. Independent 55 includes the same feature and should be allowed for the same reason.

Independent Claim 14 is allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently “logic . . . configured to . . . determine whether the data violates the agreement.” The Office Action points to Column 6, lines 25-47 of *Dan* as an alleged disclosure of this feature, but this is incorrect. This portion of *Dan* describes an automatic generation of code used to implement a service contract – not logic configured to determine whether the data violates the agreement. Furthermore, Applicants are unaware of a disclosure in *Epsteine*, which could reasonably be interpreted as a disclosure of logic configured to determine whether the data violates the agreement. For at least this reason, Applicants submit that Independent Claim 14 and its dependents should be allowed.

Independent Claim 14 is further allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently “logic . . . configured to . . . disallow communication of the data from the first virtual private proxy to the second virtual private proxy when the data violates the agreement.” The Office Action acknowledged that *Dan* does

not disclose this feature. *See* Office Action, page 3. Rather, the Office Action pointed to *Epsteine* at Column 8, Line 56 - Column 9, line 23, but this is incorrect. The entirety of this portion is provided above. Clearly, the portion provides no disclosure of logic configured to disallow communication of the data from the first virtual private proxy to the second virtual private proxy when the data violates the agreement. For at least this additional reason, Applicants submit that Independent Claim 14 and its dependents should be allowed.

Independent Claim 26 is allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently “responding to violations of the agreement based on the agreement.” The Office Action points to Column 6, lines 25-47 of *Dan* as an alleged disclosure of this feature, but this is incorrect. This portion of *Dan* describes an automatic generation of code used to implement a service contract – not responding to violations of the agreement based on the agreement. Furthermore, Applicants are unaware of a disclosure in *Epsteine*, which could reasonably be interpreted as a disclosure of responding to violations of the agreement based on the agreement. For at least this reason, Applicants submit that Independent Claim 26 and its dependents should be allowed.

Independent Claim 41 is allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently “logic . . . configured to . . . respond to violations of the agreement based on the agreement.” The Office Action points to Column 6, lines 25-47 of *Dan* as an alleged disclosure of this feature, but this is incorrect. This portion of *Dan* describes an automatic generation of code used to implement a service contract – not logic configured to respond to violations of the agreement based on the agreement. Furthermore, Applicants are unaware of a disclosure in *Epsteine*, which could reasonably be interpreted as a disclosure of logic configured to respond to violations of the agreement based on the agreement. For at least this reason, Applicants submit that Independent Claim 41 and its dependents should be allowed.

Independent Claim 55 is allowable because *Dan* and *Epsteine*, even when combined, fail to disclose, expressly or inherently “determining whether the data is allowed by the agreement.” The Office Action points to Column 6, lines 25-47 of *Dan* as an alleged disclosure of this feature, but this is incorrect. This portion of *Dan* describes an automatic generation of code used to implement a service contract – not determining whether the data is allowed by the agreement. Furthermore, Applicants are unaware of a disclosure in *Epsteine*, which could reasonably be interpreted as a disclosure of determining whether the data is

allowed by the agreement. For at least this reason, Applicants submit that Independent Claim 55 should be allowed.

Applicants additionally challenge the Office Action's alleged motivation to combine and modify features from *Dan* and *Epsteine*, which was recited as follows:

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to disallow communication between proxies when the data violation is detected as taught by Epsteine et al. One of ordinary skill in the art would have been motivated to perform such a modification in order to allow only traffic conforming to a predetermined security policy.

(Final Office Action, Pages 3, 4, 5, 8, and 9.) This conclusory reasoning falls short of the required evidence of a motivation to combine and/or modify prior art references. *See Ex Part O'Donnell*, Appeal No. 2004-0421 (The Board found that the Examiner's reason, "it would have been within the scope of one of ordinary skill in the art to combine the teachings of [the references] to achieve further corrosion resistance," an inadequate reason as to why there is a motivation to combine the references.). As indicated above, neither *Dan* nor *Epsteine* et al. teach determining whether the data violates the agreement between the first and second parties. Accordingly, in order to establish a *prima facie* rejection, at a minimum, evidence as to a motivation for a modification of one or both of the references would be necessary. The PTO has provided no such evidence.

Applicants additionally provide a reminder that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See, e.g., In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at the claimed...salt."). With this motivation and other motivations in the Office Action, the PTO has provided no references which indicate such desirability – other than the PTO bald assertion that "it would be obvious."

Further, "[t]he factual inquiry whether to combine references must be thorough and searching." (*In re Sang-Su Lee*, 277 F.3d 1338, 1343). "[An] examiner's conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.*

Furthermore, simple hindsight speculation that “it would have been obvious” to make the proposed combination is insufficient under M.P.E.P.¹ guidelines and governing Federal Circuit case law.² Moreover, such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”³ For at least this additional reason, Applicants submit that Independent Claim 1 and its dependents should be allowed. The remaining independent claims and their dependents should be allowed for analogous reasons.

New Claims

Applicants submit New Claims 56-73. Independent Claim 56 is believed to be allowable because the applied references do not disclose alone or in combination, expressly or inherently, the feature of “receiving data through a first virtual private proxy of the secure switch that complies with the parameters specified by the profile” in conjunction with the remaining features of Independent Claim 56. Independent Claim 67 is believed to be allowable because the applied references do not disclose alone or in combination, expressly or inherently, the feature of “logic . . . configured to . . . receive data through a first virtual private proxy of the secure switch that complies with the parameters specified by the profile” in conjunction with the remaining features of Independent Claim 68. The remaining new claims are allowable as dependents of Claims 56 and 68.

¹ See, e.g., M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

² For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).

³ See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Request for Evidentiary Support

Should any of the above asserted rejections be maintained, Applicants respectfully request appropriate evidentiary support. Additionally, if the Examiner is relying upon "common knowledge" or "well known" principles to establish the rejection, Applicants request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. Furthermore, to the extent that the Examiner maintains any rejection based on an "Official Notice" or other information within the Examiner's personal knowledge, Applicants respectfully request that the Examiner cite a reference as documentary evidence in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. 1.104(d)(2).

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Applicants reserve the right to discuss the distinctions between the applied art and the claims in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Ryan S. Loveless, Attorney for Applicants, at the Examiner's convenience at (214) 953-6913.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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